

REMARKS

Applicant respectfully requests favorable reconsideration and allowance in view of the following remarks and amendments. Claims 1 and 22 are amended. Accordingly, claims 1-20 and 22 are pending in the application.

I. Claims Rejected Under 35 U.S.C. § 101

Claims 1-20 stand rejected under 35 U.S.C. § 101 as being directed toward non-statutory subject matter.

In regard to the Examiner's assertion that the claims do not recite a physical transformation (e.g., transforming "materials" to "a different state or thing"), lacking a transformation of physical matter, by itself, does not render the claims non-statutory. According to MPEP 2106(IV)(C)(2), "physical transformation 'is not an invariable requirement, but merely one example of how a mathematical algorithm [or law of nature] may bring about a useful application.'" See MPEP 2106(IV)(C)(2), (citing AT&T Corp. v. Excel Communications, Inc., 172 F.3d 1352 at 1452 (Fed. Cir. 1999)).

Moreover, MPEP 2106(IV)(C)(2) states, "[i]f the examiner determines that the claim does not entail the transformation of an article, then the examiner shall review the claim to determine if the claim provides a practical application that produces a useful, tangible, and concrete result." In determining whether the claim is for a practical application, the focus is on whether the *final result* achieved by the claim is *useful, tangible, and concrete*. See MPEP 2106(IV)(C)(2) (citing State Street Bank & Trust Co. v. Signature Financial Group, 149 F.3d 1368 (Fed. Cir. 1998)). Contrary to the Examiner's assertion that the claims are not directed to statutory subject matter, as explained below, the claims recite elements that directed to a practical application that produce a useful, tangible, and concrete result.

In regard to claim 1, Applicant respectfully submits that claim 1 provides a practical application that produces a useful, tangible, and concrete result. For example, claim 1 recites the following elements:

identifying target objects on an electronic storefront Web site to which customer traffic is to be targeted, wherein identifying the target objects includes performing a

search for the target objects located in an electronic catalog separate from the electronic storefront Web site;

automatically generating search keywords for the target objects that are identified and found by the search; and

initiating purchase of the search keywords from one or more search partners.

One of ordinary skill in the art would consider the generation of search keywords for target objects (e.g., products) and then purchasing of the search keywords to be a practical application related to obtaining a future search result that refers to the target objects (e.g., based on the purchased search keywords from search partners). See e.g., Specification, paragraph [0060]. In this fashion, the generation of search keywords and the purchase of the search keywords from search partners increases the visibility of target objects in search results and leads to increased purchases of the target objects.

Similarly, the Court in State Street held that claims involving the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constituted a practical application of a mathematical algorithm, formula, or calculation, because it produced a useful, concrete and tangible result (i.e., the final share price). See State Street, 149 F.3d at 1373-74; see also AT&T, 172 F.3d at 1358 (claims drawn to a long-distance telephone billing process containing mathematical algorithms were held patentable subject matter because the process used the algorithm to produce a useful, concrete, tangible result without preempting other uses of the mathematical principle.). Therefore, as a matter of law, because claim 1 is drawn to the practical application of obtaining a search result that refers to the target objects (e.g., by purchasing the generated search keywords from search partners), it can be discerned that claim 1 produces a useful, concrete and tangible result. Thus, in view of at least these foregoing reasons, claim 1 is directed to statutory subject matter. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 1.

Moreover, dependent claims 2-20 are also directed to statutory subject matter because these claims were rejected solely because of their dependencies on claim 1. Accordingly, reconsideration and withdrawal of the rejection of claims 2-20 are respectfully requested.

II. Claims Rejected Under 35 U.S.C. § 103

Claims 1-20 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2002/0169760 filed by Cheung et al. (hereinafter “Cheung”) in view of U.S. Patent Publication No. 2004/0093327 filed by Anderson et al. (hereinafter “Anderson”) in further view of U.S. Patent Publication No. 2002/0052925 filed by Kim et al. (hereinafter “Kim”).

Claim 1, as amended, recites the elements of “identifying target objects on an electronic storefront Web site to which customer traffic is to be targeted, wherein identifying the target objects includes performing a search for the target objects located in an electronic catalog separate from the electronic storefront Web site,” and “automatically generating search keywords for the target objects that are identified and found by the search” (emphasis added). Support for the amendments may be found, for example, in paragraphs [0051]-[0054] of the Specification. Cheung fails to teach or suggest these elements. The Examiner has conceded (see last paragraph on page 3 of the Final Office Action) that Cheung and Anderson fail to teach or suggest the elements related to “an electronic catalog,” as recited in claim 1. Consequently, Cheung and Anderson fails to teach or suggest the elements of “identifying target objects on an electronic storefront Web site to which customer traffic is to be targeted, wherein identifying the target objects includes performing a search for the target objects located in an electronic catalog separate from the electronic storefront Web site,” (emphasis added) as recited in amended claim 1 as well.

Further, Kim fails to teach or suggest the above missing cited elements. Kim discloses a method for delivering ad content to a user through an “e-catalog.” See Kim, paragraph [0042]. However, no search takes place to locate ad content in the e-catalog. In particular, Kim discloses that ad content is, first, uploaded to an advertising server. See Kim, paragraph [0043]. Next, Kim teaches, “[t]he information or advertisement, once presented, is *transferred to an e-catalog* (electronic catalog) along with more detailed information, which provides automatic categorization, automatic expiration, or update” (emphasis added). Id. A transfer of the ad

content to the e-catalog is **not equivalent** to the elements of “performing a search for the target objects located in an electronic catalog,” (emphasis added) as recited in amended claim 1. Moreover, the transfer of ad content in Kim supports a conclusion that the ad content is not “located in an electronic catalog,” as required in amended claim 1, because transferring the ad content is needed if the ad content was **not in the e-catalog of Kim**. Thus, for at least these reasons, Kim fails to teach or suggest each element in amended claim 1.

In addition, the Examiner has cited to paragraph [0010] of Cheung as allegedly disclosing the elements related to “automatically generating keywords,” as recited in claim 1. Applicant notes that this cited portion of Cheung teaches, “[i]n a web-based search on an Internet search engine, a user *enters a search term* comprising one or more keywords, which the search engine then uses to *generate, in real time, a listing of web pages* that the user may access via a hyperlink” (emphasis added). See Cheung, paragraph [0010]. In other words, Cheung is describing a typical usage of a search engine where the user enters in search keywords and then the search engine presents search results to the user. This is not what is recited in amended claim 1. Again, amended claim 1 recites the elements of “automatically generating search keywords for the target objects that are identified and found by the search” (emphasis added). At the very least, Cheung fails to meet the required temporal relationship between the “search keywords” and “the search” in amended claim 1. In particular, Cheung teaches (1) the user, first, enters in search keywords into the search engine; and (2) then the search results are generated by the search engine for display. Therefore, Cheung fails to teach or suggest the generation of search keywords for target objects that are identified **and found by the search** because the search has not been performed by the search engine in Cheung before the user enters in the search keywords. Thus, the search keywords entered by the user fail to satisfy the required inter-relationship of being generated for “target objects that are identified **and found by the search**,” (emphasis added) as recited in amended claim 1. As a result, Cheung fails to teach or suggest the elements of “automatically generating search keywords for the target objects that are identified and found by the search,” (emphasis added) as recited in amended claim 1.

Thus, in view of at least the reasons set forth above, Cheung in view of Anderson in further view of Kim fails to teach or suggest each element of amended claim 1. In addition, dependent claims 2-20 are patentable over the art of record because each of these claims depends

on claim 1. Accordingly, reconsideration and withdrawal of the rejection of claims 1-20 are respectfully requested.

With respect to independent claim 22, this claim, as amended, recites analogous elements to those in claim 1. Therefore, for at least the reasons discussed above in connection with claim 1, Cheung in view of Anderson in further view of Kim fails to teach or suggest each element of amended claim 22. Accordingly, reconsideration and withdrawal of the rejection of claim 22 are respectfully requested.

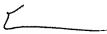
CONCLUSION

In view of the foregoing, it is believed that all claims now pending patentably define the subject invention over the prior art of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (408) 720-8300.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

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Michael J. Mallie Reg. No. 36,591

1279 Oakmead Parkway
Sunnyvale, CA 94085-4040
(408) 720-8300